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EXAMINER

DARJI, PRITESH D

ART UNIT

PAPER NUMBER

1793

NOTIFICATION DATE

DELIVERY MODE

11/09/2009

ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

USPTO@SUGHRUE.COM
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DETAILED ACTION

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 9 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 9, "an element selected from... and zinc" is improper Markush language and thus indefinite. See MPEP 2173.05(h) I.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-9 and 17 are rejected under 35 U.S.C. 103(a) as obvious over Sano (US 2003/0092936).

Sano teaches catalyst for production of acetic acid. Sano teaches contact between carrier and solution having water and palladium compound. See [0063]. Carrier is further contacted with a group 14, 15 or 16 element (e.g. tellurium chloride) dissolved an alkaline substance water. See [0072-0073] and [0121]. Resulted palladium compound loaded catalyst is reduced to obtain a supported catalyst. See [0123].

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Inclusion of at least one element from group 6 and groups 11-12 is stated. Chromium chloride and zinc chlorides can be used. See [0097-0098] and [0125]. Sano further teaches use of heteropolyacid (e.g. tungstophosphoric acid) during the catalyst production. The hetero atom is phosphorous or silicon and the polyatom is at least one from tungsten and molybdenum. See [0191-0193] and page 27, column 1, lines 8-20.

The taught loading of heteropolyacid may differ from that instantly claimed.

It would have been obvious to one of ordinary skill in the art at the time of the invention to have loading of heteropolyacid at last step because the selection of any order of mixing ingredients is prima facie obvious. See *Ex parte Rubin* 128 USPQ 440 (Bd. App. 1959), *In re Burhans*, 154 F.2d 690, 69 USPQ 330 (CCPA 1946), and *In re Gibson*, 39 F.2d 975, 5 USPQ 230 (CCPA 1930). See MPEP 2144.04 [R-6] IV C.

Regarding “that is used for... oxygen” in claim 1, a preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951).

Response to Arguments

Applicant's arguments filed on 8/17/2009 have been fully considered but they are not persuasive.

Applicant argues that Sano does not teach catalyst being useful in the production of acetic acid from ethylene and oxygen but instead teaches catalyst to produce acetic acid and ethyl acetate from ethanol and oxygen.

However, a preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951).

Applicant argues that the paragraphs [0072], [0073] and [0121] cited by the Examiner do not teach “an alkaline substance as water”.

However, in the paragraphs stated above, Sano teaches element b (tellurium chloride) to be dissolved in water (alkaline substance). The alkaline substance required by the claim is water. See [0073]. Water with pH more than 7.0 makes it alkaline. Sano does not limit use of only pure water (pH=7.0). Therefore, it would have been obvious for an ordinary skilled artisan to use water with little higher pH because “[W]here the general conditions of a claim are disclosed in the prior art, it is not inventive to discover the optimum or workable ranges by routine experimentation.” *In re Aller*, 220 F.2d 454, 456, 105 USPQ 233, 235 (CCPA 1955)

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to PRITESH DARJI whose telephone number is (571)270-5855. The examiner can normally be reached on Monday to Thursday 8:00AM EST to 6:00PM EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Stanley Silverman can be reached on 571-272-1358. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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/P. D./

Examiner, Art Unit 1793

/Steven Bos/

Primary Examiner, Art Unit 1793